

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and withdrawal of the rejections of the application in view of the above amendments and following remarks, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND RECORD OF TELEPHONE INTERVIEW

Claims 1-17 and 19-40 are pending in this application. Claims 5-6 and 25-26 have been withdrawn from consideration and claim 18 has been canceled. In the Office Action mailed March 30, 2006, claims 1-4, 7-17, 19-24 and 27-40 are rejected. By this Amendment, claims 1 and 24 are amended to include the limitations of claims 15 and 35, respectively, and claims 15 and 35 are canceled without prejudice to its subsequent prosecution in any continuing application or disclaimer of the proprietary rights set forth therein. No new subject matter is added as a result of the claim amendments.

Initially, Applicants would like to thank Examiner Piziali for granting a telephone interview on June 29, 2006 with Applicants' representatives R. Santucci and A. Mustillo during which the Office Action mailed March 30, 2006 and the references cited therein were discussed. Specifically, Applicants' representatives discussed the fact that U.S. Patent No. 5,744,236 to Rohrbach et al. ("Rohrbach") seems to teach away from a conductive fabric that allows for continued exposure of a conductive polymer as the surface of the monofilament wears such that the filament retains its conductivity. The Examiner indicated that arguing along these lines may traverse the rejections; however, he stated that he would need to see the argument in writing before making a decision.

Applicants' representatives also discussed the fact that the instant invention is directed to industrial fabrics which are very different from fabrics for use in dust proof clothes as disclosed

in U.S. patent No. 6,432,850 to Takagi et al. ("Takagi") and nonwoven filter media as disclosed in Rohrbach. No agreement as to specific claim language was reached.

II. THE REJECTIONS UNDER 35 U.S.C. § 103(a)

In numbered paragraph 3 of the Office Action, claims 1-4, 7-8, 11-17, 19-22, 24, 27-28, 31-37 and 39-40 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takagi in view of Rohrbach. In numbered paragraph 6 of the Office Action, claims 9-10, 23, 29-30, and 38 are rejected § 103(a) as allegedly being unpatentable over Takagi in view of Rohrbach and further in view of U.S. Patent No. 4,803,096 to Kuhn et al. ("Kuhn"). The rejections are traversed for at least the following reasons.

As recited in amended independent claims 1 and 24, the instant invention is directed to polymeric filaments and the industrial fabrics constructed therefrom, wherein the polymeric filaments comprise, *inter alia*, "one or more C-shaped grooves with a mouth having a width less than the width of the central portion of the groove" wherein an electrically conductive polymer substantially fills the C-shaped grooves, "and wherein the one or more C-shaped grooves allow for continued exposure of the conductive polymer to the filament surface as the monofilament wears so that the filament retains its conductivity." (Emphasis added). Substantially filling the C-shaped grooves with the electrically conductive polymer is advantageous because it allows continued exposure of the highly conductive polymer to the surface of the fabric even as the monofilament wears while also shielding and protecting the conductive polymer material.

Instant Application, page 6, lines 4-12.

On page 4 of the Office Action, when discussing claims 15-16 and 35-36, the Examiner asserts that the configuration taught by Rohrbach allows for continued exposure of the conductive polymer to the filament surface as the monofilament wears so that the filament

retains its conductivity. Applicants respectfully disagree with this assertion. First, Rohrbach is directed to fibers for use in nonwoven filter media having cavities that entrap powdered activated carbon adsorbent particles. *See Rohrbach*, col. 1, lines 45-63. To form the filter media of Rohrbach, solid particles are aggressively rubbed into the individual fibers. The procedure used to accomplish this dry impregnation is to take the fibers and liberally dust them with the adsorbent powder. The powder particles are rolled into the fiber several times. The powder particles which remain within the cavities of the fibers are surprisingly stable and resistant to physical action. *See id.* at col. 3, lines 38.

Rohrbach further discloses that they do not know the exact reason why the particles remain within the cavities but they believe it is a keystone type mechanical entrapment effect where the particles seem to engage each other and do not spill from the cavities through the cavity openings. *See id.* at col. 3, lines 37-42. Lastly, and most importantly, Rohrbach states, "[w]e tried impregnating trilobal fiber in which the outer ends or caps of the lobes 26 were removed. Very little carbon particles were retained by such fibers." *Id.* at col. 3, lines 42-45. Consequently, Applicants assert that if the tops or caps of the T-shaped lobes (indicated in the below drawing, which is an annotated version of Figure 3 from Rohrbach) were to wear, the keystone type mechanical entrapment effect within the cavities would fail, causing the powder particles to spill or fall-out of the cavities.

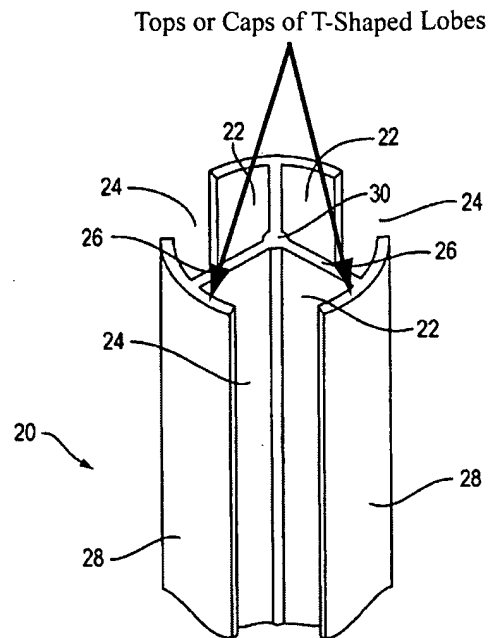


FIG. 3

Therefore, Applicants assert that Rohrbach teaches away from a monofilament that allows for continued exposure of the conductive polymer to the filament surface as the monofilament wears so that the filament retains its conductivity.

It is well established that if a reference teaches away from an invention, that finding can defeat an obviousness claim grounded on that reference. *See Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000). In addition, a "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *Id.* at 1350 (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

The instant case presents a textbook example of a reference teaching away from the result sought by the applicant. As discussed above, the instant invention is advantageous in that the monofilaments and hence the fabric, remain electrically conductive as the monofilaments wear because of continued exposure of the conductive polymer to the monofilament surface.

Therefore, the skilled artisan, confronted with the problem faced by the Applicant, namely the need for a highly durable electrically conductive fabric, would clearly have been led away from the approach taken by Applicants after having read the Rohrbach reference because, as previously discussed, as the Rohrbach fiber wears, the powder particles entrapped within the cavities would spill out, resulting in a fiber that would not have the same characteristics and properties as a fiber still containing the powder particles.

Consequently, because Rohrbach teaches away from the instant invention and because all of the rejections are based on Rohrbach in combination with Takagi and Kuhn, the § 103 rejections must fail as a matter of law.

Furthermore, Rohrbach is not directed to monofilaments that contain an electrically conductive polymer material for use in an industrial fabric conductive. Consequently, a person of skill in the art would not look to Rohrbach when trying to design an electrically conductive monofilament that remains electrically conductive when worn.

Lastly, as previously stated, Takagi is directed to dust proof clothing and Rohrbach is directed to nonwoven filter media while, as claimed, the instant invention is directed to industrial fabrics. Applicants respectfully point out that the preambles for the instant claims are more than a statement of use. In other words, the present claims are directed to and limited to industrial fabrics. This is not a mere intended use. This is a specific article. Without it, the claim would be lacking in meaning.

This situation is analogous to that in *Corning Glass Works v. Sumitomo Electric*, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989). In that case the court held that the use of the term "optical waveguide" did not merely state a purpose or intended use. Rather, it gave "life and meaning" to the claim and provided a further positive limitation to the invention claimed. The

court in making its determination looked to the entire patent to determine and gain an understanding as to what the inventors actually invented and intended to encompass by the claim. The court noted that "[t]o read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality."

So to here, to read the claim language to cover all types of fabrics would be divorced from reality. It is clear from the specification that the invention is directed towards industrial fabrics. The environments in which industrial fabrics are used are much harsher and therefore require more durable fabrics than fabrics used in clothing or for filter media. Industrial fabrics must be able to withstand the ravages of the industrial machinery on which they are used. Accordingly, a skilled worker would not look to a fabric for use in an article of clothing or fibers for use in filter media as being applicable to industrial fabrics. This is not a mere intended use. This is a specific article. Without it, the claim would be lacking in meaning.

Accordingly, just as in Sumitomo, the Takagi and Rohrbach references do not have the limitation of an industrial fabric.

In view of the above, it is respectfully submitted that the pending claims are not rendered obvious over Takagi and Rohrbach.

For at least the foregoing reasons, Applicants respectfully submit that revised independent claims 1 and 24 patentably distinguish over Takagi, Rohrbach and Kuhn, either alone or in combination because the relied upon portions of the cited references fail to teach each and every limitation of revised claims 1 and 24 or motivate a person skilled in the art to modify or combine the references to practice the claimed invention. Therefore, claims 1 and 24 are allowable. Further, claims 2-4, 7-17, 19-23 and 39, which depend from claim 1, and claims 27-38 and 40, which depend from claim 24, are allowable therewith.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicants' undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

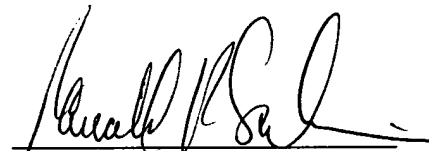
CONCLUSION

In view of the foregoing, Applicants believe that all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By:



Ronald R. Santucci
Reg. No. 28,988
(212) 588-0800